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*S.R.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/458,415 12/10/99 GILLESPIE

K 06129-156001

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QM12/0104

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EXAMINER

TIMOTHY A FRENCH  
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225 FRANKLIN STREET  
BOSTON MA 02110

STASHICK, A

ART UNIT

PAPER NUMBER

3728

*#6*

DATE MAILED:

01/04/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.

09/458,415

Applicant(s)

GILLESPIE, KEVIN

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-48 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8 and 47, drawn to an outsole with inner members, classified in class 36, subclass 30 A.
  - II. Claims 9-25, drawn to an outsole with grooves on outer surface in the forefoot area, classified in class 36, subclass 59 C.
  - III. Claims 26-34, drawn to grooves located only in the toe region of an outsole, classified in class 36, subclass 7.2.
  - IV. Claims 35-45, drawn to the front part of a sole having grooves and ridges, classified in class 36, subclass 7.1 R.
  - V. Claim 46, drawn to a rounded heel outsole, classified in class 36, subclass 114.
  - VI. Claim 48, drawn to a combination of an outsole with inner and outer members, grooves, and ridges, classified in class 36, subclass 102.

Being that invention VI appears to be a linking claim, this claim will be examined with the applicant's choice from the other five inventions.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II, III, IV, and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as an outsole for cushioning the impact of the user's foot with the ground whereas invention II can be used for creating better traction with the ground in the forefoot region, invention III can be used to produce better toe off, invention IV can be used to create better traction as well as cushioning of the foot during use, and

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invention V can be used to allow better translation of energy from the heel to toe during the running gait. See MPEP § 806.05(d).

3. Inventions II and I, III, IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case invention II can be used for creating better traction with the ground in the forefoot region, invention I has separate utility such as an outsole for cushioning the impact of the user's foot with the ground, invention III can be used to produce better toe off, invention IV can be used to create better traction as well as cushioning of the foot during use, and invention V can be used to allow better translation of energy from the heel to toe during the running gait. See MPEP § 806.05(d).

4. Inventions III and I, II, IV and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III can be used separately to produce better toe off, invention I has separate utility such as an outsole for cushioning the impact of the user's foot with the ground, invention II can be used for creating better traction with the ground in the forefoot region, invention IV can be used to create better traction as well as cushioning of the foot during use, and invention V can be used to allow better translation of energy from the heel to toe during the running gait. See MPEP § 806.05(d).

5. Inventions IV and I, II, III and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as being used to create better traction as well as cushioning of the foot during use, invention I has separate utility such as an outsole for cushioning the impact of the user's foot with the ground whereas invention II can be used for creating better traction with the ground in the forefoot region, invention III can be used to produce

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better toe off, and invention V can be used to allow better translation of energy from the heel to toe during the running gait. See MPEP § 806.05(d).

6. Inventions V and I, II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention V has separate utility as being used to allow better translation of energy from the heel to toe during the running gait, invention I has separate utility such as an outsole for cushioning the impact of the user's foot with the ground whereas invention II can be used for creating better traction with the ground in the forefoot region, invention III can be used to produce better toe off, and invention IV has separate utility such as being used to create better traction as well as cushioning of the foot during use. See MPEP § 806.05(d).

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, the search required for any one invention is not required for any other invention, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. A telephone call was made to Timothy French on December 26, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T. Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where

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this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ADS  
January 3, 2001

A handwritten signature in black ink, appearing to read "Anthony Stashick".

**Anthony Stashick**  
**Patent Examiner**